

## ARGUMENT

### I. Rejected Claims

Claims 1-159 are pending in the application, of which Claims 158 and 159 are new, and Claims 1-71 and 92-157 were previously withdrawn from consideration.

Examiner rejected Claims 72-78, 84, 85, and 89 as anticipated under 35 U.S.C. §102(b) by Hendrickson et al. (USPN 4,757,015) ("Hendrickson"). Examiner rejected Claim 91 as anticipated by, or in the alternate, as obvious under 35 U.S.C. § 103(a) over Hendrickson. Examiner objected to Claims 79-83, 86-88 and 90 as being dependent on rejected claims, but stated these claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicant amends independent Claim 72 to incorporate the limitations of Claim 88, and adds independent Claims 158 and 159, which incorporate the limitations of Claims 82 and 83, respectively, into the language of Claim 72. Accordingly, Applicant cancels Claims 82, 83 and 88. Applicant also amends Claim 78.

Applicant hereby requests further examination and reconsideration of the application in view of the foregoing amendments. Applicant believes that, in view of these amendments, all of the remaining claims are in condition for allowance.

#### A. Anticipation

The Examiner rejected Claims 72-78, 84, 85, and 89 as anticipated by disclosure citing to a support having a coating of a gelled network of inorganic oxide particles having a uniform thickness in col. 6, ll. 11-29 of Hendrickson. Hendrickson fails to anticipate because it does not disclose the composition of the invention recited in the rejected claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. V. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in ... claim." 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP 2131.

Hendrickson fails to disclose a composition in which a different compound is attached to each of the porous coatings (per the limitation of Claim 88 imported into Claim 72, as currently amended). Hendrickson fails to disclose a

composition in which each of the separate porous coatings occupies an area on the substrate of less than about 10,000  $\mu\text{m}^2$  (per the limitation from Claim 82 imported into the language of Claim 72, as in new Claim 158). Hendrickson fails to disclose a composition in which the porous coatings have a surface area measuring greater than 50 meters<sup>2</sup>/g (per the limitation of Claim 83 imported into Claim 72, as in new Claim 159). Since these amendments effectively rewrite Claim 88, 82, and 83, respectively, in independent form, Claims 72, 158 and 159 are allowable as per Examiner's finding (at p. 5 of Paper No. 13) that Hendrickson did not teach, *inter alia*, "the number of coated regions, the size of coated regions, [and] the surface area of coated regions." Because remaining Claims 73-78, 84, 85, and 89 all depend from Claim 72 these claims are also not anticipated by Hendrickson in view of its failure to read on the invention recited in the independent base claim.

#### **B. Obviousness.**

The Examiner rejected Claim 91 as anticipated or, in the alternative, as obvious over the silica sol of Hendrickson. Claim 91 depends from Claim 72, and so fails to be anticipated by Hendrickson in view of Applicant's present amendment to that claim. Claim 91 is allowable as per Examiner's finding that Hendrickson did not teach or suggest the composition of the number and size of coated regions as required by the claimed invention.

#### **II. Consideration of Method-of-Making Claims Corresponding to Claim 72**

In paper 6, Examiner deemed composition-of-matter claims (Group I: Claims 1-41, 72-91, 149 and 153-157) as a separate invention from those inventions recited in method-of-making claims (Group II: Claims 42-71 and 92-134) and method-of-using claims (Group III: Claims 135-148 and 150-152).

Applicant requests rejoinder under MPEP 821.04 of method-of-making Claims 92-128, and for Examiner's consideration of the patentability of these claims in connection with the subject application.

Method-of-making Claims 92-128 correspond to Claim 72; these contain the same limitations as Claim 72 (also as currently amended). Since Claim 72 as amended is in a

condition for allowance in view of Examiner's finding that Hendrickson does not teach, *inter alia*, the number of coated regions, then the method-of-making and method-of-use claims depending from Claim 72 or reciting all of the limitations of Claim 72 are also not anticipated by and nonobvious over Hendrickson under *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). Accordingly, method-of-making Claims 92-128 are allowable on the same bases as composition-of-matter Claim 72 and its dependents.

### **III. Remaining Species**

#### **A. Composition-of-Matter Claims**

In paper 6, in addition to restricting applicant's invention into three groups (discussed, *supra*), Examiner required election from three species of composition-of-matter claims constituting coated articles: 1) having a continuous porous coating wherein the porous coating has two or more different compounds attached thereto, 2) having at least two discrete regions with continuous porous coatings wherein each porous coating has at least one compound attached thereto, 3) wherein the porosity of the coating ranges from 0.15 to 0.99, and 4) comprising a substrate having at least five separate distinct porous coating per square centimeter. Applicant elected the second species and identified Claims 72-91, which were considered in the subsequent office action. Upon amending Claim 72 to put Claims 72-91 in a condition for allowance (see argument, *supra*), Applicant respectfully calls Examiner's attention to the remaining composition-of-matter claims, including Claims 1, 154 and 156 and their dependent claims (Claims 2-41, 149 and 153; 155; and 157, respectively).

Applicant currently amends Claims 1, 154 and 156 and requests that Examiner consider the corresponding species in connection with the present application. As stated in Applicant's argument *supra*, Examiner held in the last Office Action that Hendrickson does not teach or suggest a coated article having the number, size, and surface area of the coating material as recited in dependent Claims 79-83, 86-88 and 90. Further, Hendrickson does not teach or suggest a porous coating with two or more different compounds attached, as required by Claim 1.

Applicant amends Claim 1 and Claim 156 to incorporate the limitations of the allowable subject matter pertaining to the size of the coated regions by incorporating the limitations of Claim 37 into each of these independent claims. Hendrickson fails to disclose a composition in which two or more different compounds are attached to a porous coating wherein the compounds are attached at known discrete full thickness volumes, each occupying an area on the substrate of less than 1,000,000  $\mu\text{m}^2$ , as required by Claim 1 and Claim 156, so amended.

Applicant also amends Claim 154 to incorporate the limitations of the allowable subject matter pertaining to the surface area of the coating material by incorporating the limitations of Claim 83 into that claim. Hendrickson fails to disclose a composition in which the porous coatings have a surface area measuring greater than 50 meters<sup>2</sup>/g, as required by Claim 154, so amended.

Applicant respectfully submits that Claims 1, 154, and 156 are now in a condition for allowance. Claims 2-41, 149 and 153 (dependent from Claim 1), Claim 155 (dependent from Claim 154), and Claim 157 (dependent from Claim 156) are also not anticipated by Hendrickson in view of its failure to read on the invention recited in the currently amended base claims.

#### **B. Method-of-Making and Method-of-Using Claims**

Method-of-making Claims 129-134 and method-of using Claims 135-148, 150 (currently amended), 151 and 152 multiply depend from Claims 1 and 72. Applicant requests rejoinder of those claims insofar as these depend from Claim 72.

Applicant amends method-of-making Claim 42 to incorporate the limitations of allowable subject matter pertaining to size of the coated regions by incorporating the limitations of Claim 37. Accordingly, Claim 42 and its dependents, Claims 43-71, now include all of the limitations of Claim 1, as currently amended.

If Examiner deems Claim 1 in a condition for allowance, including for the reasons argued above, Applicant requests rejoinder of method-of-making Claims 42-71 and 129-134, and method-of-using Claims 135-148 and 150-152. These claims depend from or incorporate all of the limitations of Claim 1, as currently amended. If Claim 1 as amended is allowable as per Examiner's finding that Hendrickson did not teach, *inter*

*alia*, the number of coated regions, then the method-of-making and method-of-use Claims depending from Claim 1 or reciting all of the limitations of Claim 1 are also not anticipated by and nonobvious over Hendrickson under *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1996). See MPEP 821.04. Accordingly, method-of-making claims 42-71 and 129-134, and method-of-using Claims 135-148 and 150-152 are allowable on the same bases as composition-of-matter Claim 1 and its dependents.

#### **IV. Conclusion**

Applicant hereby requests further examination and reconsideration of the claims of the subject application in view of the foregoing amendments. Applicant believes that after these amendments all of the remaining claims are in condition for allowance.

Respectfully submitted,



---

Peter J. Knudsen  
Registration No. 40,682

Attorney for Applicant